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No. 95-26

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,
*Respondents.***On Writ Of Certiorari To The**
United States Court of Appeals
For The Federal Circuit**BRIEF OF AMICUS CURIAE**
AIRTOUCH COMMUNICATIONS, INC.
IN SUPPORT OF RESPONDENTS**ALLAN N. LITTMAN**
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BRIEF OF AMICUS CURIAE
AIRTOUCH COMMUNICATIONS, INC.
IN SUPPORT OF RESPONDENTS

INTEREST OF AMICUS CURIAE

With the consent of the parties,¹ AirTouch Communications, Inc. ("AirTouch") respectfully offers this brief as amicus curiae in support of respondents Westview Instruments, Inc., and Althon Enterprises, Inc. AirTouch is not a business rival of any of the parties to this action. AirTouch

¹ Letter of consent from counsel for both Petitioners and Respondents have been filed with the Clerk of the Court pursuant to Supreme Court Rule 37.

has no interest, direct or indirect, in the outcome of this appeal.

AirTouch is a leading provider of wireless telecommunications services such as cellular telephone and paging services. AirTouch competes in a rapidly growing industry where patent rights are an important factor in many major business decisions. Uncertainty about the scope and meaning of patent claims has adverse effects on that industry: it impedes business efforts to license patents on commercially reasonable terms, it complicates technical efforts to avoid infringement, and it often frustrates legal efforts to resolve infringement claims without substantial delays and costs of litigation. AirTouch believes that the en banc decision of the Court of Appeals in this case articulates a well-reasoned and long-precedented approach to allocating judge and jury functions in patent infringement cases, reducing the uncertainty surrounding patent interpretation while at the same time preserving to patent owners their Seventh Amendment right to a trial by jury in actions to enforce their patents against infringers.

SUMMARY OF ARGUMENT

American patent law requires that an applicant for a United States patent file a specification that shall contain a written description of the invention in "full, clear, concise, and exact terms" (35 U.S.C. section 112, ¶ 1), and "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." *Id.* ¶ 2. Thus, it is the *claims* of a patent that define the scope of the exclusionary right created by the patent grant, much as real property boundaries are defined by metes and bounds. See, e.g., *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917).

In *Coupe v. Royer*, 155 U.S. 565 (1895), this Court held that in determining whether a patent claim is infringed, it is for the judge, and not the jury, to interpret the scope of that claim:

"Where the defence denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant."

155 U.S. at 579 (citation omitted). The question now before this Court is whether the rule of *Coupe* is to be nullified in every case in which the meaning of some term in the claims, specification or prosecution history of the patent is materially disputed.

We respectfully submit that the decision of the Court of Appeals below, and the rule from *Coupe* on which that decision was in part based, achieves a proper balance between the rights of a patent owner to have a jury trial on infringement issues and the rights of the public to rely upon patent claims as clear and exact legal descriptions of what has been removed from the public domain. This balance, which has endured for more than a century, would be disrupted if juries suddenly were assigned the legal task of interpreting patent claims whenever a patent owner and an accused infringer, or their respective expert witnesses, disagree about the meaning of a patent claim. This Court observed long ago that in cases involving the interpretation of patent claims, "[e]xperience has shown that opposite opinions of persons professing to be experts may be obtained to any amount." *Winans v. New York & Erie R.R. Co.*, 62 U.S. 88, 101 (1859).

The rule advocated by Petitioners and their amici would effectively subvert the *Coupe* rule by assigning the legal issue of claim interpretation to juries, whose verdicts on the issue of infringement are subject to review only under a "substantial evidence" standard. If juries were given that virtually unreviewable discretion to interpret patents, it would become far more difficult to form reasonable judgments concerning the breadth of any patent claim. Such a rule would impair the ability of business competitors to make reasonable commercial decisions about patent licensing and related matters, hamper their ability to resolve patent disputes without litigation and complicate the appellate review of judgments in patent cases.

In examining Petitioners' contention that *Coupe v. Royer* does not really mean what the opinion so clearly says, the Court should note Petitioners' repeated failure to distinguish the legal issue of patent claim *interpretation* from factual issues such as infringement and adequacy of disclosure in the patent specification. For example, Petitioners' citations to older English cases in which juries decided the issue of infringement miss the point. The question before this Court is not who decides the issue of infringement, but who interprets the claims of the patent. None of the pre-1791 English cases cited by Petitioner or the dissenting opinion below involved any instruction to the jury to interpret the meaning of patent claims.

This Court's precedent holds that the interpretation of the claims of a patent is a matter for the trial court, not the jury. There is no legitimate Seventh Amendment argument for overruling that precedent and the stare decisis of more than a century.

ARGUMENT

I. THE MAJORITY DECISION OF THE EN BANC PANEL SHOULD BE AFFIRMED BASED ON ENDURING PRECEDENT HOLDING THAT PATENT CLAIM INTERPRETATION IS A LEGAL ISSUE TO BE DECIDED BY JUDGES AND REVIEWED DE NOVO AS A QUESTION OF LAW.

The dissenting and concurring opinions below assert, incorrectly, that the majority decision contravenes 200 years of legal precedent.² Petitioners are less hyperbolic, but no less incorrect, in arguing that the majority decision "ignored clear historical evidence that juries, not judges, interpreted patents in England in 1791 and thereafter in England and United States." See Brief of Petitioners ("Pet. Br."), p. 22. In fact, the historical evidence suggests no such thing. To the extent that history and precedent inform the resolution of this appeal, they support affirmance of the en banc majority decision of the Court of Appeals.

A. The precedents of this Court have long held that patent interpretation is a matter of law, to be decided by the trial judge and reviewed de novo on appeal.

The majority opinion below correctly concluded that the precedents of this Court have established that "the construction of a patent claim is a matter of law exclusively for

²The opinions of the Court of Appeals are found in the Appendix to the Petition for Certiorari at pages 1a-159a, and are cited as such in this brief. Judge Mayer's concurring opinion asserts that the majority decision "jettisons more than two hundred years of jurisprudence" and "marks a sea change in the course of patent law that is nothing short of bizarre." 57a. Similarly, Judge Newman's dissenting opinion asserts that the majority decision "denies 200 years of jury trial of patent cases in the United States, preceded by over 150 years of jury trial of patent cases in England, by simply calling a question of fact a question of law." 87a.

the court." 25a (citing authorities).³ This Court has long held that proof of patent infringement involves at least two separate and distinct issues: (1) the legal interpretation of the patent claim at issue; and (2) the factual question of whether the defendant's accused product or process infringes that patent claim. The former is a legal issue to be resolved by the trial court; the latter is a factual issue to be decided by the factfinder.

This Court delineated these two distinct issues more than 140 years ago. In *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), the Court began its opinion by setting out the law applicable to cases in which the patent owner contends that its patent was infringed:

"On such a trial, two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used, or sold by the defendants.

"The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury."

56 U.S. at 337 (emphasis added).

This Court elaborated the fundamental distinction between these issues of interpretation and infringement in

³The majority opinion below relied on *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 235 (1853); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 333 (1853); *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 100 (1859); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 816 (1870); *Coupe v. Royer*, 155 U.S. 565, 579-580 (1895); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904); 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 731, at 481 (1890); and George T. Curtis, *A Treatise on the Law of Patents for Useful Inventions* § 222, at 251 (4th ed. 1873).

Coupe v. Royer, 155 U.S. 565 (1895). The *Coupe* Court expressly distinguished between the legal issue of patent interpretation and the factual question of patent infringement:

"The doctrine of the cases is aptly expressed by Robinson in his work on Patents, vol 3, page 378, as follows: 'Where the defence denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant.'"

Id. at 579 (quoting 3 William C. Robinson, *The Law of Patents for Useful Inventions* § 1075, at 378 (1890)).

The Robinson treatise is especially instructive as to the state of American and English patent law at the time of *Coupe*. Professor Robinson aptly summarized the law holding that the interpretation of patent claims is a legal issue reserved to the courts,⁴ and he described the uncertainty

⁴See, e.g., 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 732, at 481-83 (1890):

"The duty of interpreting letters-patent has been committed to the courts. A patent is a legal instrument, to be construed, like other legal instruments, according to its tenor. Whether its Claims are valid or invalid, whether or not they embrace a given invention, and what may be the actual nature of the invention which they do embrace, are questions of law for the court, to be decided upon an inspection of the instrument itself. No evidence of any kind, no opinions of other persons, can have any direct influence upon this decision. Where technical terms are used, or where the qualities of substances or operations mentioned or any similar data necessary to the comprehension of the language of the patent are unknown to the judge, the testimony of witnesses may be received on these subjects, and any other means of information may be employed. But in the actual interpretation of the patent the court proceeds upon its own responsi-

that would result if juries were given the responsibility for claim interpretation.⁵

The Robinson treatise also noted that courts interpreting patent claims should consider not only the words of the patent, but also the "state of the art at the date of the invention [as] may be shown by previous patents, by the processes or instruments then known to the art, or by the testimony of persons acquainted with its general history and development." 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 740, at 492 (1890) (footnote omitted). Courts interpreting the claims of a patent should appreciate that:

"The nature of the actual invention is sought in the history of the art, in the formal statements of the inventor before his patent issued, and in other facts which indicate its character. To this invention the entire description of the patent is applied, and whatever

bility, as an arbiter of the law, giving to the patent its true and final character and force." (footnotes omitted)

⁵See, e.g., 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 733, at 483-84 (1890):

"Apart from the general principles upon which this duty of interpretation is entrusted to the court, there are advantages attending it which the inventor could not otherwise enjoy. To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would at once deprive the inventor of the opportunity to obtain a permanent and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of a false interpretation, from the consequences of which he could not escape. By confiding this duty to the court, however, its decision as to the nature of the patented invention becomes reviewable to the same extent as any other legal question, and when his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations." (footnotes omitted)

has been properly described and might, therefore, lawfully be claimed, is taken as the true interpretation of the Claim so far as the legitimate use of language will allow. *By this method of construction the rights of the inventor are secured to the fullest extent which is compatible with the preservation of the public right.*"

Id. § 745, at 501 (emphasis added) (footnote omitted).

The *Coupe* Court followed the precedent and reasoning summarized in the Robinson treatise, holding that:

"Our conclusion upon this part of the case, therefore, is, that the question of infringement, arising upon a comparison of the Royer patent and the machine used by the defendants, should be submitted to the jury, *with proper instructions as to the nature and scope of the plaintiffs' patent as hereinbefore defined*, and as to the character of the defendants' machine."

155 U.S. at 579-80 (emphasis added).

The holding of *Coupe* is contrary to the position urged by Petitioners. The *Coupe* Court knew that expert opinion evidence had been offered at trial regarding the meaning of the patent as well as how it might be infringed, but the Court specifically held that interpretation of the patent was for the trial judge, not the jury. In so holding, the Court was well aware of the different functions of judges and juries on the issues of interpretation and infringement.⁶

⁶The Court referred to its having "had occasion, more than once, to reverse the trial courts for taking away from the jury the question of infringement, which they have sometimes done by rejecting evidence of earlier patents offered to show anticipation, and sometimes by a peremptory instruction that a patent relied on by the defence was or was not infringement of the plaintiff's patent." *Id.* at 577-78. It was in this connection, infringement rather than interpretation of the patent in suit, that the Court referred to *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453,

Coupe and *Winans v. Denmead* provide ample support for the ruling below and are consistent with this Court's precedents in other patent cases that involve different issues. For example, in the earlier case of *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848), this Court distinguished the legal issue of patent interpretation from the factual issue of whether the patent made a disclosure that could be understood by persons skilled in the art. The *Hogg* Court held that adequacy of disclosure is basically a factual question, which "involves a question of law only in part, or so far as regards the construction of the written words used." 47 U.S. at 438 (emphasis added). See also *Hogg v. Emerson*, 52 U.S. (11 How.) 587 (1851) (affirming 47 U.S. 437).

Similarly, in *Winans v. New York & Erie Railroad Co.*, 62 U.S. (21 How.) 88 (1859), this Court reiterated the basic distinction between the legal issue of patent interpretation decided by the court and the related factual issue to be decided by the jury. The defendant in *Winans* argued that the patent was invalid for lack of novelty, and the Court accordingly held that "[t]here was in fact but one question to be decided by the court, viz: the construction of the patent; the question of novelty being the fact to be passed on by the jury." 62 U.S. at 100.

Petitioners argue that the rule declared in *Coupe* and *Winans v. Denmead* applies only in cases where there is no material dispute regarding the meaning of any term of the patent. Pet. Br., pp. 31-35. Petitioners' asserted distinction is nonsensical. It effectively concedes that there exists a class of legal issues reserved for decision by courts interpreting patent claims in at least some cases. One must ask what those legal issues are, if they are not the issue of how the claim is properly construed in light of the language of the

455 (1872), and *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814 (1882). *Coupe*, 155 U.S. at 578-79.

claim, the patent specification, the prosecution history and the prior art.

A careful reading of *Coupe* and the cases cited by Petitioners demonstrates that Petitioners are wrong. The *Coupe* case itself involved a significant and highly material dispute over the meaning of the claims of the patent. The parties disagreed whether the shaft in the machine was required to be vertical, and both sides presented conflicting extrinsic evidence and testimony on the subject. *Id.* at 568-76. Despite these evidentiary conflicts, this Court itself, in a jury case, interpreted the patent. *Id.* at 577.

Silsby v. Foote, 55 U.S. (14 How.) 218 (1853), was decided 42 years before *Coupe* and addressed an issue that was eliminated by the 1870 statutory amendment requiring inventions to be "distinctly claimed." The patent specification in *Silsby* did not "point out and designate the particular elements which compose a combination, but only declared, as it properly could, that the patented combination was made up of so much of the described machinery as effects a particular result." 55 U.S. at 226. In other words, patent law at the time *Silsby* was decided permitted the specification to describe the invention in terms only of its expected result, without specifying the proportions of the combination. It was only in that exceptional and now disallowed circumstance that this Court stated, taking care in the process not to overstate, that "it is a question of fact which of the described parts are essential to produce that result; and to this extent, *not the construction of the claim, strictly speaking, but the application of the claim, should be left to the jury.*" *Id.* at 226 (emphasis added).

In *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1869), the Court considered the defense of patent invalidity based on the existence of a prior art patent. Plaintiff sued defendant for breach of a covenant to assign defendant's patent, but further argued that defendant's patent was invalid in any

case because the invention described in the patent had been previously described in an earlier English patent. 76 U.S. at 813. The *Bischoff* Court held that the trial court could not "pronounce upon the identity or diversity" of the inventions described in the two patents as a matter of law, and held that the trial court had properly submitted that issue to the jury as a question of fact. *Id.* at 814. The *Bischoff* Court was careful, however, to distinguish that factual issue from the legal issue of patent interpretation. Its opinion confirmed that the interpretation of patent language (as distinct from the comparison of the described invention with the prior art) is an issue for the court, and not the jury. *Id.* at 815-16. The *Bischoff* Court concluded its opinion by expressly clarifying that distinction:

"This view of the case is not intended to, and does not, trench upon the doctrine that the *construction* of written instruments is for the court alone. It is not the *construction of the instrument*, but the *character of the thing invented*, which is sought in questions of identity and diversity of inventions."

76 U.S. at 816 (original emphasis).

The Court followed *Bischoff* in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872). The sole issue in *Tucker* was whether the trial court erred in excluding a prior art patent offered by defendant to demonstrate the invalidity of the patent in suit. 80 U.S. at 455. Citing *Bischoff*, the *Tucker* Court held that the prior art patent should have been admitted into evidence and reversed the judgment of the trial court without any discussion of patent interpretation. *See id.* at 456.

We do not disagree with Petitioners' thesis that material factual disputes as to whether an accused product infringes a patent claim present an issue of fact for the jury. But that thesis does not entail that material disputes as to the

meaning of a patent claim convert an issue of law into an issue of fact for a jury. The proper interpretation of a patent claim is a legal issue that begins and ends with the court, regardless of whether there is a dispute about the meaning of the claim language.

B. The English common law circa 1791 did not treat patent interpretation as a question of fact for the jury.

Petitioners and the dissenting opinion below argue that patent interpretation is a jury function, based upon the English patent law circa 1791, as incorporated into the Constitutional right to trial by jury guaranteed by the Seventh Amendment. *See* Pet. Br., pp. 23-25; 118a-129a (Newman, J., dissenting); *see also* 66a-67a (Mayer, J., concurring).

None of those discussions cites a single case in which an English court ever instructed a jury to interpret the language of the patent in suit. Their failure to distinguish between the legal issue of patent interpretation and the factual issue of patent infringement is epitomized by the conclusion of Judge Newman's dissenting opinion, in which she summarizes the older English cases as establishing that "in seventeenth- and eighteenth-century England, patent infringement was tried to a jury at common law." 129a (Newman, J., dissenting). We do not understand Respondents to dispute that *infringement* is a jury question. The question at issue is not who determines whether the patent has been infringed, but who interprets the claims of the patent so as to make that determination possible.

Petitioners' argument was implicitly rejected by this Court in *Coupe v. Royer*, 155 U.S. 565 (1895), and by Professor Robinson in his classic treatise on *The Law of Patents* (1890), on which the *Coupe* Court relied. *See, supra*, pp. 7-9. The Robinson treatise refers to virtually all of

the English cases cited by Petitioners, but evidently did not regard them to dictate a different rule.

It is not clear that Petitioner's argument on this point is even germane, given that English patents circa 1791 did not have claims of the type used in the United States. As this Court warned in *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848), American courts should not allow themselves to be misled by precedent in older English patent cases because of the differences between American and English patent law. 47 U.S. at 479, 483. Accord: *Water-Meter Co. v. Desper*, 101 U.S. (11 Otto) 332, 337 (1880).

More important, none of the reported English cases cited by Petitioners or in the concurring and dissenting opinions below held that patent interpretation is anything but a legal issue. Indeed, those cases involved almost every issue except patent interpretation in the context of deciding infringement. See *Rex v. Else*, 1 Carp. P.C. 103 (K.B., N.P. 1785) (patent held void for failure to describe a patentable invention); *Dollond's Case*, 1 Carp. P.C. 28 (C.P. 1758) (patent held valid despite prior use of invention by another person); *Morris v. Branson*, 1 Carp. P.C. 30 (K.B. 1776) (patent for an addition to existing machine held valid); *Bramah v. Hardcastle*, 1 Carp. P.C. 168 (K.B. 1789) (patent held valid against defense of lack of novelty); *Arkwright v. Nightingale*, 1 Carp. P.C. 38 (C.P. 1785) (patent held valid against defense of inadequate disclosure); *Rex v. Arkwright*, 1 Carp. P.C. 53 (K.B. 1785) (patent found invalid for lack of novelty and lack of invention by the patentee); *Turner v. Winter*, 1 T.R. 602 (K.B. 1787) (patent held invalid for inadequate disclosure); *Administrators of Calthorp v. Waymans*, 3 Keb. 710 (K.B. 1676) (patent held invalid because invention had never before been used in England).

In none of those cases did the trial court instruct the jury to interpret the patent in suit. That Petitioners do not cite a single reported case holding that patent interpretation was a

jury function confirms that there was *not* a settled common law practice of submitting the issue of patent interpretation to juries in England prior to 1791.

Lacking any reported pre-1791 English authority to support their position, Petitioners rely on secondary accounts of an unreported English case, *Liardet v. Johnson* (1778). Pet. Br., pp. 23-24.⁷ *Liardet* should be disregarded as an unreported case lacking any real value as a legal precedent. More important, it should also be disregarded because it provides no precedent for instructing a jury to interpret the patent in suit: in neither the first nor the second trial did Chief Justice Mansfield tell the jury to interpret the patent.⁸ Whatever he may have thought on the subject of whether the judge or jury should interpret patents, there is no record of him holding in *Liardet* that the question was one for the jury.

Notably, when the English rule on patent interpretation was definitively declared a century later, it was fully consistent with *Coupe*. In *Brooks v. Steele and Currie*, 14 R.P.C. 46 (1897), the court held that expert testimony was admissible in patent cases to explain technical terms, demonstrate

⁷ Although Petitioners describe *Liardet* as a "leading King's Bench decision" (Pet. Br., p. 23), their purported summary of this unreported case is based entirely upon the descriptions provided in 1 James Oldham, *The Mansfield Manuscripts and the Growth of English Law in the Eighteenth Century* 748-757 (1992), and Francis Buller, *An Introduction to the Law Relative to Trials at Nisi Prius* 76 (1791).

⁸ See 1 James Oldham, *The Mansfield Manuscripts and the Growth of English Law in the Eighteenth Century*, 754-57 (1992). Judge Buller's notes state that Mansfield left to the jury "all objections made to exactness, certainty and propriety of the Specification . . . and whether [the invention had been] publicly used by others before" (*id.* at 756), but thereafter, the single question left to the jury was "whether this was a fair and new invention." *Id.* at 757. See also John N. Adams & Gwen Averly, *The Patent Specification: The Role of Liardet v. Johnson*, 7 J.Legal Hist. 156-177 (1986).

the technology, summarize the prior art and identify differences between the plaintiff's patent and defendant's accused product. 14 R.P.C. at 73. The *Brooks* court held, however, that the value of such evidence does not change the fundamental nature of patent interpretation as an issue of law for the court:

"But after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are examined."

Id. at 73.

We respectfully submit that Petitioners' inaccurate and secondary account of the unreported decision in the case of *Liardet v. Johnson* does not warrant, let alone require, that this Court reverse the century-old precedent of *Coupe v. Royer*. Even if one were to accept Judge Buller's cryptic notes concerning the instruction given at the end of the second trial, they would reflect nothing more than a procedure similar to that announced in *Silsby* under the pre-1870 United States Patent Statute. *See, supra*, p. 11.

C. The precedents of the Federal Circuit support the en banc decision below, and any conflicting precedents from the Federal Circuit should be overruled.

Petitioners and their supporting amici also criticize the majority decision for ignoring earlier precedents of the Federal Circuit. *See* Pet. Brief, pp. 18-19; ATLA Amicus Br., pp. 7-10; Litton Amicus Br., pp. 8-9; *see also* 135a-145a (Newman, J., dissenting); *see also* 59a-61a (Mayer, J., concurring). To the extent that such criticism might be at all relevant to this appeal, we would point out that it simply misstates the decisional law of the Federal Circuit.

In its first year of existence, the Federal Circuit expressly adopted and followed the binding precedents of this Court on the subject of patent interpretation. In *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760 (Fed. Cir. 1983), the court quoted from *Coupe v. Royer* and Robinson's "classic" treatise on patent law:

"[W]here the defendant 'denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the Claims; the jury judge whether the invention so defined covers the art or article employed by the defendant.'"

Kalman, 713 F.2d at 770-71 (quoting *Coupe*).

Similarly, in *SSIH Equipment S.A. v. United States Int'l Trade Comm'n*, 718 F.2d 365, 376 (Fed. Cir. 1983), the court cited *Winans v. Denmead* for the proposition that:

"With respect to infringement, the question of 'what is the thing patented' is one of law, while the question 'has that thing been constructed [made], used or sold' by the alleged infringer is a factual issue."

718 F.2d at 376 (quoting *Winans v. Denmead*, 56 U.S. at 337) (brackets in original).

Subsequent Federal Circuit decisions continued to follow the rule in *Coupe* in a variety of procedural contexts. *See, e.g., Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1569-71 (Fed. Cir. 1983) (citing *Kalman* and *SSIH*, and reversing judgment of trial court as a matter of law); *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1118 (Fed. Cir. 1985) (in banc) (reversing summary judgment of noninfringement and construing disputed claim language as a matter of law); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986 (Fed. Cir. 1988) (reversing judgment of noninfringement and construing disputed claim language as a matter of law); *Senmed, Inc. v. Richard-Allan Medical*

Indus., Inc., 888 F.2d 815, 818 (Fed. Cir. 1989) (reversing jury verdict of infringement and construing disputed language in patent claims as matter of law); *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822-823 (Fed. Cir. 1992) (quoting *Winans v. Denmead* and affirming denial of JNOV motion based in part on trial court's correct interpretation of disputed claim language).

Before the concurring and dissenting opinions in *Markman*, no Federal Circuit opinion had ever suggested that there was a Seventh Amendment right to a jury trial on the legal issue of claim interpretation. No such contention is made by the cases cited in the *Markman* dissent or in the briefs of Petitioners or their supporting amici.⁹ Rather, those cases feature much more limited holdings: that summary judgment may be inappropriate in cases where extrinsic evidence is required to permit the court to construe the claims, e.g., *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); that parties may agree to submit the issue of claim interpretation to the jury, see *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 614 (Fed. Cir. 1984); or, wrongly, that the "construction of the claim *could* be left to the jury," see *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir. 1984) (emphasis added) (dictum).

Petitioners' contention that there are two divergent lines of Federal Circuit precedent on this issue does not bear close scrutiny. To the extent that such a split of authority might exist, however, this Court should prefer that line

⁹We note that the brief of amicus curiae Litton Industries, Inc. refers to the split decision in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (en banc) (per curiam), petition for cert. filed, 64 U.S.L.W. ____ (Nov. 6, 1995). Litton Amicus Br., pp. 7, 21. The *Hilton Davis* case involves a distinct set of issues relating to the so-called "doctrine of equivalents" and is now the subject of a pending petition for certiorari.

which clearly follows *Kalman* and this Court's own decisions in *Coupe* and *Winans v. Denmead*. The majority decision of the en banc panel in this case resolved any such conflict in favor of those enduring precedents. Here, as in other areas of patent law that affect the public interest, this Court should exercise its authority to resolve such legal disputes in accordance with this Court's own settled precedents. See, e.g., *Cardinal Chemical Co. v. Morton Int'l, Inc.*, 113 S. Ct. 1967 (1993) (disapproving former Federal Circuit practice of dismissing declaratory judgment claims on patent validity issues as moot upon any finding that the patent in suit was not infringed).

D. The Federal Rules of Evidence relating to expert testimony are consistent with the decision of the en banc court below.

The amicus brief of the Association of Trial Lawyers of America ("ATLA") argues summarily that disputes over patent claim interpretation are questions of fact and, therefore, must be determined by juries. The ATLA brief does not even mention *Coupe v. Royer*, 155 U.S. 565 (1895), which is squarely contrary to its argument that "If the terms and facts were in dispute, the issue of claim interpretation has always been held as a question of fact." ATLA Brief, p. 4. The ATLA amicus brief argues that patent interpretation will be a jury function whenever expert witnesses present testimony about the meaning of disputed language. See ATLA Brief, pp. 12-14.

That argument, which is based on Rule 702 of the Federal Rules of Evidence ("Rule 702"),¹⁰ assumes that the trial court can hear expert testimony *only* as a trier of fact.

¹⁰That rule provides as follows: "If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise." Fed. R. Evid. 702.

The Court in *Coupe* considered highly contested expert testimony on the meaning of the patent claims while expressly holding that claim interpretation is a matter of law. See *Coupe*, 155 U.S. at 568-76. Similarly, in *Winans v. New York & Erie R.R. Co.*, the Court expressly recognized that experts may be examined "to explain terms of art, and the state of the art, at any given time. They may explain to the court and jury the machines, models, or drawings, exhibited . . . [and] point out the difference or identity of the mechanical devices involved in their construction." 62 U.S. at 100-101.

Claim construction does not suddenly become a jury issue merely because one party hires an expert witness to opine as to the scope of the claim under Rule 702. As we noted above, section 112 commands that a patent specification must be in full, clear, concise and exact terms and must conclude with claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." See, *supra*, p. 2. Implicit in these requirements of specificity is a principle at the heart of this case—a patent claim must have a fixed and determinate scope that provides a meaningful guide to the rest of the world.¹¹ A patent claim is not a "nose of wax" that can be

¹¹ See, e.g., *Merrill v. Yeomans*, 94 U.S. (4 Otto) 568, 573-74 (1876) ("The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits those rights. . . . It seems to us that nothing can be more just and fair, both to the parties and the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent."); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. (5 Otto) 274, 278-79 (1877) ("As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public."); *McClain v. Ortmyer*, 141 U.S. 419, 423-24 (1891) ("Nothing is better settled in the law of patents than that

reshaped as the patent owner may desire. *White v. Dunbar*, 119 U.S. 47, 51-52 (1886). Property boundaries are and must be fixed if the public is to rely on their integrity. To allow expert witnesses, acting as advocates, to distort the definition of patent claims is inconsistent with the nature of such claims as property rights.

We respectfully submit that allowing juries to interpret the meaning of patent claims, insulated from any meaningful review by the trial judge or court of appeals, subverts the statutory requirement of specificity and fosters the deliberate use of ambiguous claim language. In summary, the statutory requirements of section 112 reinforce the precedent and policy directing that patents are to be interpreted by the courts, and should not be interpreted, directly or indirectly, by juries.

the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public"); *Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 400-01 (1926) (same).

II. CONCLUSION

For the reasons set forth herein, we respectfully submit that the judgment of the Court of Appeals should be affirmed.

December 8, 1995.

Respectfully submitted,

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